

Patent
Serial No. 10/803,717
Attorney Docket No. 9H01.1-011

In the Claims:

1. (Currently amended) A clip for attaching a gutter cap to a gutter, the clip comprising:

a front portion having a shape ~~configured to interlock~~ adapted to be interlocked with a front hem edge of a gutter;

a back portion having a shape ~~configured to interlock~~ adapted to be interlocked with an edge of a gutter cap; and

a support bracket having a shape ~~configured to rest~~ adapted to be rested against an inside surface of the gutter to maintain the clip in an installment position.

2. (Currently amended) The clip of claim 1, further comprising:

a variable fastening gutter attachment portion ~~configured~~ adapted to receive a fastening device that is fastened to a back portion of the gutter, wherein the variable fastening gutter attachment portion enables the clip to be used with gutters of different sizes.

3. (Currently amended) The clip of claim 2, wherein the variable fastening gutter attachment portion has an opening formed therein and wherein the fastening device is a screw that is screwed into the back portion of the gutter by a variable amount, and wherein the amount by which the screw is screwed into the back portion of the gutter depends at least in part on the size of the gutter.

4. (Currently amended) The clip of claim 1, wherein said back portion of the clip has a shape ~~configured to interlock~~ adapted to be interlocked with a hem edge of a gutter cap.

5. (Canceled)

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REMARKS

Status of Claims

Claims 1-4 have been amended. Claim 5 has been canceled. Four (4) claims (Claims 1-4) remain pending in this application through this Amendment. The Applicant respectfully requests further examination of the application.

Election/Restriction

The Examiner requests confirmation of the provisional telephonic election made by Daniel Santos, one of the Applicant's representatives, of the species represented by Figs. 7-8. This election is hereby confirmed. Claims 1-4, all claims pending in the application, are believed to read on this species.

Objections to the Claims

The Examiner objects to Claim 2 on the grounds that the term "variable fastening portion" is inconsistent with the use of the term "gutter attachment portion" in the specification. The Applicant has therefore amended Claim 2 as requested by the Examiner, although the word "variable" has been retained because it is believed to contribute to the clarity of the claim. The term "varying" is in fact used in the specification in connection with the gutter attachment portion. For example, in paragraphs 41-42 of the Applicant's specification it is stated that the "clip 80 includes a gutter attachment portion 84 having an opening formed therein through which a screw can be inserted. . . ." and that "the clip 80 can be used with gutters of different sizes and styles by varying the amount by which screw 85 is screwed into the back surface 92 of the gutter 90." The Applicant believes the specification makes clear that, in the illustrated embodiment of the invention, it is the screw-and-screwwhole combination that makes the gutter attachment portion "variable" (though in other embodiments other types of variable gutter attachment portions could be used). The word "variable" thus has a meaning that is clearly conveyed by the specification and, accordingly, "variable gutter attachment portion" is believed to be the term best suited for this element of the invention as set forth in Claim 2. In view of the foregoing, the Applicant respectfully believes the objection has been overcome.

Objections to the Drawings

The Examiner objects to the drawings on the grounds that a "variable fastening portion" as claimed in Claim 2 must be shown in the drawings or that feature canceled from the claim. The Applicant respectfully submits that the

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"variable gutter attachment portion" as recited in amended Claim 2 is clearly shown in the drawings and was formerly referred to as a "variable fastening portion" in Claim 2 prior to this Amendment. As noted above, the screw-and-screwhole combination, which is clearly shown in Figs. 7-8, represents the "variable gutter attachment portion" in an exemplary embodiment of the invention. In view of the foregoing, the Applicant respectfully requests withdrawal of this objection.

Rejection of Claims 1-5 under 35 U.S.C. §112, ¶ 2

Claims 1-5 stand rejected under 35 U.S.C. §112, ¶ 2, as being indefinite on the grounds that the recitation of "the amount" in Claim 3 lacks antecedent basis, and that in Claims 1-5 it is unclear whether the claim is drawn to a clip alone or the combination of a clip, gutter, and gutter cap.

With regard to Claim 3, the Applicant has amended the claim to provide antecedent basis.

With regard to the invention to which Claims 1-5 are drawn, the Applicant is pleased to clarify that the claims are directed to the clip alone. The Applicant believes this is clear from the preamble of Claim 1, from which the other claims depend: "A clip for attaching a gutter cap to a gutter, the clip comprising:" As suggested by the Examiner, the Applicant has amended the claims so that the phrase "configured to" is replaced by "adapted to be." The Applicant believes these terms are synonymous, and that the amendment does not alter the scope of the claims, but the Applicant is glad to comply with the Examiner's suggestion if it is believed it will improve the clarity of the claims. In view of the foregoing, the Applicant respectfully requests withdrawal of this rejection.

Rejection of Claims 1-5 under 35 U.S.C. §102(b) – Leroney et al.

Claims 1-5 stand rejected under 35 U.S.C. §102(b) as being anticipated by *Leroney et al.* (U.S. Patent No. 5,619,825). The Applicant respectfully traverses this rejection.

With regard to Claim 1, from which Claims 1-4 depend, the Applicant respectfully submits that *Leroney et al.* does not disclose a front portion having a shape adapted to be interlocked with a front hem edge of a gutter, a back portion having a shape adapted to be interlocked with an edge of a gutter cap, and a support bracket having a shape adapted to be rested against an inside surface of the gutter to maintain the clip in an installment position. Rather, *Leroney et al.* discloses a

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"gutter support" (28) "which is adapted to nest inside the upper front wall of the gutter under the lip 24. The gutter support has an elongated stiffening portion 30 terminating in a U-shaped portion 31 adapted to fit over the top of the back wall 16 of the gutter and be nailed to the wall 14 of the building to support the gutter." (*Leroney et al.*, col. 2, lines 31-37.)

The back portion of the gutter support of *Leroney et al.* does not have a shape adapted to be interlocked with an edge of a gutter cap. Indeed, *Leroney et al.* does not even address gutter caps. Rather, *Leroney et al.* discloses supporting a gutter screen on the tops of the gutter supports. A gutter screen comprises an open mesh, as shown in Fig. 3 of *Leroney et al.* In contrast, a gutter cap, as that term is used in the art, comprises a largely solid (non-open) surface, as its primary function is to prevent debris from falling into the gutter. Gutter screens were seen by practitioners in the art as a solution to the debris problem before gutter caps were introduced. Gutter caps were exceedingly well-received in the art and have now largely supplanted gutter screens. Thus, there is an art-recognized difference between gutter screens and gutter caps.

Notwithstanding the difference between gutter caps and gutter screens, if for the sake of argument the broadest reasonable interpretation of "gutter cap" includes a gutter screen, the gutter support disclosed in *Leroney et al.* still does not have a shape adapted to be interlocked with the edge of the gutter screen/cap, as recited in Claim 1. Rather, as noted above, the gutter support merely provides a support upon which an edge of the screen can rest. There is no interlocking between the screen and the support; the screen merely rests on the tops of the supports. (See *Leroney et al.*, col. 2, lines 38-44 and Figs. 2 and 6.)

Furthermore, the gutter support of *Leroney et al.* does not have a shape adapted to rest against an inside surface of the gutter. A gap between the bottom of the gutter support and the top inside surface of the gutter is clearly discernible in Figs. 2 and 6. Indeed, rather than resting upon it, the front of the gutter support holds up the gutter. Stated another way, the lip of the gutter is hung on the front of the gutter support. The weight of the gutter is hanging from the front of the gutter support and, to the extent this results in sagging, tends to contribute to the gap between the front edge of the gutter and the gutter support. Any incidental contact between the front of the gutter support and the gutter hung from it is not the result of

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the gutter support by design having "a shape adapted to rest against an inside surface of the gutter," as recited in Claim 1.

Because *Leroney et al.* does not disclose any of the above-discussed features recited in Claim 1, it cannot anticipate Claim 1. Claims 2-4 include these same limitations by dependency and therefore also cannot be anticipated by *Leroney et al.*

Claims 2-4 are further believed not anticipated by *Leroney et al.* for additional reasons. With regard to Claim 2, *Leroney et al.* does not disclose a variable gutter attachment portion that receives a fastening device to enable the clip to be used with gutters of different sizes. Rather, *Leroney et al.* discloses that the gutter supports are nailed to the wall of the building. There is no provision for varying anything to correspond to the size of the gutter; the supports are simply nailed to the wall. In contrast, in the exemplary embodiment of the Applicant's invention, a relatively long screw can be screwed into the wall by a variable amount to accommodate gutters of different size. Not only can this not readily be done with a nail, but *Leroney et al.* does not disclose or suggest anything about adjustability or variability to accommodate gutters of different sizes.

With regard to Claim 3, the Applicant respectfully disagrees with the Examiner's statement that the fastening device disclosed by *Leroney et al.* is a screw. *Leroney et al.* clearly states that it is a nail: "The gutter support has an elongated stiffening portion 30 terminating in a U-shaped portion 31 adapted to fit over the top of the back wall 16 of the gutter and be nailed to the wall 14 of the building to support the gutter." (*Leroney et al.* col. 2, lines 34-37.) The fastener shown in Fig. 2 is a nail, not a screw. While the difference between a nail and a screw may be a mere matter of design choice in other contexts, it is important with regard to the structure of the variable attachment portion Claim 3. Moreover, as discussed above, *Leroney et al.* in no way discloses or suggests nailing the back portion of the gutter by a variable amount to accommodate gutters of different sizes. Indeed, in view of the way that such gutter supports are mounted, it would seem that nailing the supports only partially into the building would diminish the security with which the gutters are fastened to the building. It should be kept in mind that in the context of the Applicant's invention, it is not the gutter supports that are screwed in by a variable amount, but rather only the novel clip that holds the gutter cap; the

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gutter itself remains mounted to the building in the conventional manner, such as with gutter supports.

With regard to Claim 4, as discussed above, the back portion of the gutter support of *Leroney et al.* does not have a shape adapted to interlock with anything, let alone a hem edge of a gutter cap. As discussed above with regard to Claim 1, the gutter screen simply rests upon the top of the gutter support; there is no "interlocking."

For at least the foregoing reasons, the Applicant respectfully submits that Claims 1-4 are not anticipated by *Leroney et al.* and respectfully requests reconsideration and withdrawal of this rejection.